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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,343	06/26/2001	Wendy Ann Belluomini	AUS920010349US1	2241
45502	7590	04/18/2006	EXAMINER	
DILLON & YUDELL LLP 8911 N. CAPITAL OF TEXAS HWY., SUITE 2110 AUSTIN, TX 78759				BROOKS, MATTHEW L
			ART UNIT	PAPER NUMBER
				3629

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/891,343	BELLUOMINI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Matthew L. Brooks	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 March 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
  - 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                          |                                                                             |
|--------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                         | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .                                              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                          | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### *Claim Objections*

1. **Claims 9 and 10** are no longer objected to under 37 CFR 1.75(c).
2. **Claims 12 and 16** are no longer objected to.
3. **Claim 2** is objected to. Examiner notes Applicant likely made a mistake in regards to leaving out the “compensation” component.

### *Claim Rejections - 35 USC § 112 1<sup>st</sup>*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1-16**, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner is uncertain how Applicant intends to “...determine a value...” when the consumer is internal to the organization as laid out in Applicant’s specification “some valuation method” (pg 7, 18-20), this is maintained because the applicant is still determining a value, as it is part of the step of “determining a compensation” (see below), further still to determine a valuation method would require undue experimentation.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup>***

6. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: "determining a value for the reusable design" without such a step there is no way to "determine a compensation". This is due to the fact the determining of compensation step involves multiplying the value of the design by an arbitrary number/percentage.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in the test of:

whether the invention produces a useful, concrete, and tangible result.

The present invention fails the "useful, concrete, tangible" result test. For an invention to be "useful" it must satisfy the utility requirement of section 101. The PTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP 2107. The claim must be for a practical application that produces a useful result and the Applicant should specifically recite in the claim the practical application. a claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical

application of an abstract idea, but the claim is broader than the disclosure such that it recites an abstraction, then the claim must be rejected. In the present case Applicant mentions in the specification that the value "...could be *price paid by consumer or some valuation methodology...*" Some valuation methodology is an abstract idea.

Furthermore even if Applicant were to chose V=price paid by and outside consumer the reward percentage is still left to that of an "Arbiter", which fails the concreteness requirement of section 101 because it is still unpredictable in that it is left in the hands of an arbiter to subjectively decide.

Applicant uses the words "arbiter" in the specification pg 7, 13-29 which Merriam's On-Line Dictionary defines as:

- 1 : a person with power to decide a dispute : JUDGE
- 2 : a person or agency having the power of deciding

This also lends to the argument that the value determined and the percentages thereof are not going to be concrete because the decisions are left in the hands of a subjective human being.

Furtherstill due to the response the present invention lacks concreteness. Usually concreteness arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For

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example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. See *infra*. In this regard Examiner turns to the Specification to make out how the “evaluating the opportunity for re-use” is accomplished, how a “reusable design is created”, and “how a compensation value” is determined. No enabling disclosure is present. For example pg 6, lines 6-18 a subsequent design team “may be rewarded” or the compensation “may be lower”; when is Examiner to reward and when or in what instances would it be lower? To determine this would be to invent the invention due to all of the possible outcomes that could be expected and the many hours of undue experimentation to determine the results and even still another person skilled in the art may reward completely differently, hence the invention lacks concreteness and is not enabled.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Accellerate Your Product-to-Market Process"; Larson, Mellisa; Quality, v 36, n 10, p 38-40 (Accelerate).

Accelerate teaches that the reuse of the design of components was well known in the manufacture of goods. Any manufacturer would be motivated to do this because it speeds up design process and cuts costs. Further more Accelerate teaches that manufacturers are **encouraging** designers to reuse components.

Accelerate does not teach exactly how companies are currently going about encouraging employees to reuse the design of components.

The examiner takes Official Notice that one would reward (via money or man power) an employee, purchaser, funding agent of project to meet a particular goal in a business. Evidence of this is provided by the following example of encouraging an employee to produce more product. If an employer wanted a higher volume of product produced, encouraging employees by compensation of percentage more produced would be obvious in that it would incentivize employees. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a compensation system

in the business goal of Accelerate because monetary compensation would encourage the employees to meet re-use design component goals. The use and advantages of compensation are well known.

Furthermore, in determining the obviousness of applying what is generally known in the design industry to what is known in the world business one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The reuse of design components via “boiler plate”, *to one ordinarily skilled in the art, for some time now is recognized as a vehicle which speeds up production and cuts costs.* Also, the manufacture/business industry has utilized reward/compensation systems/methods for years to motivate employees to meet a particular goal in a business. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized rewarding employees to meet the particular goal of a business (that of reuse of a components design) as that taught in the Accelerate for the purpose of encouraging employees. The desirability to do this is clearly to motivate the employee monetarily to comply/and/or/ meet the business goal.

***Response to Amendment***

11. Claims 17-22 have been canceled.
12. Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: originally Applicant claimed a system comprising an innovation producer, innovation consumer, and arbiter; now the Applicant is claiming a computer program product comprising computer readable instructions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Arguments***

13. Applicant's arguments filed 2/10/2006 have been fully considered but they are not persuasive.
14. In response to pg 7 of 9, first P; the 112 1<sup>st</sup> rejections. Applicant submits that removing the "determining a value for the reusable design" overcomes the 112 1<sup>st</sup> rejection. Examiner submits that the removal of the step strengthens the need for the rejection made. This is due to the fact that in the next step (claim 1 is being used as the representative claim) responsive to a reuse transaction "determining with a computer compensation for..." Examiner submits that if no value of the reusable design is ever determined, then according to the teaching of the disclosure no compensation can/may be determined. Because compensation is determined as a direct percentage of the value. (see 20-29) Furtherstill note that the teachings do not disclose how to figure the X-Z%'s, hence no way to figure out compensation.
15. In response to pg 7 of 9, second P; 101 rejections. First note that the "technological arts" prong that was used has been pulled and no longer applies due to the Lundgren BPAI case. However the "useful, concrete, tangible" prong is maintained. The test for "concrete" result usually arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the

process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. See *infra*.

Again in the present case Examiner cannot tell substantially repeat the invention, nor perform without undue experimentation.

16. In response to pg 7 of 9, 3<sup>rd</sup> P, first two sentences. Applicant traverses and states in the first point that “(Larson/Accelerate) explicitly encourages designers to reuse already existing components” Examiner turns to the abstract which states “manufacturers need to pare down their parts libraries” and second to “examine {} options, and ask for what is required. Manufacturers need to ensure that the resulting software programs would work well with each other” Hence pare down the boiler plate designs by making sure when manufacturers are creating the designs for new ones that they work well together (encouraging reuse).

17. In response to pg 8, first full P, Examiner took “Official notice that an employer would reward an employee, purchaser, funding agent of project to meet a particular goal

in business. Again, Larson teaches encouraging reuse of design components as the goal and Examiner took Notice to reward an employee for meeting a company goal or objective would be obvious. How else would one encourage, via a pep talk? Applicant has failed to seasonably traverse the Official Notice towards the independent claims, and rather chose to argue the obviousness thereof. As to the statement "Applicants invention recognizes that the value of achieved by reducing design times through re-using components is sufficient justification for the increase in costs..." So too does Larson on pg 2 of the reference, under photo omitted, "...essential for speeding designs along..." The rejection is maintained. (see above).

18. In reply to pg 8, second full P, the boldface assertions (NOT ARGUMENTS) that Larson is silent as to the compensation being increased head count, Applicant is directed to page 6 of the First Office Action dated 9/30/05, last full P, of the non-traversed official notice wherein the term "man power" is certainly the equivalent of head count. As to the assertion Larson does not show standardized interface (ABSTRACT, pg 1, parts library was considered the equivalent because it is the basic component/boiler plate/standard interface being used; or pg 2, top 1/3 of page "...standardized on specific software tools..."). As to the (incorporation of performance features that exceed the performance of the original design) Examiner had interpreted this and still doe interpret this as nothing more than trying to improve a design which is essentially what the whole article is about. For examples of incorporating better performance features see Larson pg 1, ABSTRACT; "...take advantage of new technologies for rapid prototyping" and pg 1, "...mission to be the world leader in the

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design...”, any person skilled in the art knows that to be a leader in design, you must incorporate better performance features. Rejection is maintained.

19. In response to the last P of pg 8, it is moot and not considered for purposes of this response because the claim was not examined due to the original presentation by Applicant.

***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. “AT&T uses CAD tools to streamline cellular design”; Valigra, Lori; InfoWorld v16n38; PP: 106; Sep 19, 1994 (attached herein). Which shows “bi-directional flow” of information; Market driven design reuse; Boiler plate design component reuse; all upon electrical devices.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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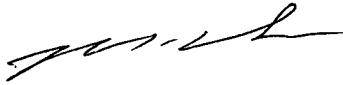
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB  
4/11/06

  
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